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ROBERT J. SCHAAP
21241 VENTURA BOULEVARD
SUITE 188
WOODLAND HILLS, CA 91364

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Director's Office
Group 3700

*In re Application of
HAYNES, JOEL E.
Application No.: 08/972,477
Filed: November 18, 1997*

DECISION ON PETITION

This is a decision on petitioner's request filed August 27, 2002 to review the holding of abandonment, mailed August 28, 2001.

The petition is dismissed.

Petitioner requests withdrawal of abandonment based upon the non-receipt of an Advisory Office Action mailed March 21, 2000. Petitioner also indicates that the Notice of Abandonment mailed August 28, 2001 was not received.

An initial review of the application reveals that it is abandoned for failure to provide a proper response to the final office action mailed on November 3, 2000.

37 CFR 1.116 states:

(a) An amendment after final action or appeal must comply with § 1.114 or this section.

(b) After a final rejection or other final action (§ 1.113) in an application or in an ex parte reexamination filed under § 1.510, or an action closing prosecution (§ 1.949) in an inter partes reexamination filed under § 1.913, amendments may be made canceling claims or complying with any requirement of form expressly set forth in a previous Office action. Amendments presenting rejected claims in better form for consideration on appeal may be admitted. The admission of, or refusal to admit, any amendment after a final rejection, a final action, an action closing prosecution, or any related proceedings will not operate to relieve the application or patent under reexamination from its condition as subject to appeal or to save the application from abandonment under § 1.135, or the reexamination from termination. No amendment can be made in an inter partes reexamination proceeding after the right of appeal notice under § 1.953 except as provided for in paragraph (d) of this section.

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(c) If amendments touching the merits of the application or patent under reexamination are presented after final rejection, or after appeal has been taken, or when such amendment might not otherwise be proper, they may be admitted upon a showing of good and sufficient reasons why they are necessary and were not earlier presented.

(d) No amendment can be made as a matter of right in appealed cases. After decision on appeal, amendments can only be made as provided in §§ 1.198 and 1.981, or to carry into effect a recommendation under § 1.196 or § 1.977.

MPEP 714.13 states:

It should be kept in mind that applicant cannot, as a matter of right, amend any finally rejected claims, add new claims after a final rejection (see 37 CFR 1.116) or reinstate previously canceled claims. Except where an amendment merely cancels claims, adopts examiner suggestions, removes issues for appeal, or in some other way requires only a cursory review by the examiner, compliance with the requirement of a showing under 37 CFR 1.116(c) is expected in all amendments after final rejection. Failure to properly reply under 37 CFR 1.113 to the final rejection results in abandonment. A reply under 37 CFR 1.113 is limited to:

(A) An amendment complying with 37 CFR 1.116;

(B) A Notice of Appeal (and appeal fee); or

(C) A request for continued examination (RCE) filed under 37 CFR 1.114 with submission (i.e., an amendment that meets the reply requirement of 37 CFR 1.111) and the fee set forth in 37 CFR 1.17(e). RCE practice under 37 CFR 1.114 does not apply to utility or plant patent applications filed before June 8, 1995 and design applications.

While petitioner supports the request by providing a statement that the Office communication was not received, attesting to the fact that a search of the file jacket and docket records indicate that the Office communication was not received, and providing a copy of the docket record where the nonreceived Office communication would have been entered had it been received, the amendment after final filed March 8, 2001 did not place the application in condition for allowance. The failure to receive the Advisory Action mailed March 21, 2000 does not stop the petitioner's obligation to ensure that a proper reply under 37 CFR 1.113 is filed.

Petitioner indicates that he believes the Office sent the Advisory Action and Notice of Abandonment to the previous attorney of record, however, a review of the actions reveals no irregularities in the mailing of the action. Copies of these actions are attached for petitioner's convenience.

Accordingly, the application remains abandoned for a failure to provide a proper response to the final office action. Petitioners may file a renewed petition, without fee, addressing the points raised above. Any request for reconsideration of this decision must be submitted within TWO

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(2) MONTHS from the mail date of this decision, 37 CFR 1.181(f). No extensions of time under 37 CFR 1.136(a) are permitted. The reconsideration request should include a cover letter entitled "Renewed Petition under 37 CFR 1.181." Petitioners may wish to consider filing a petition to revive under 37 CFR 1.137. The rules and MPEP sections cited may be found on the USPTO website at: www.uspto.gov.



Richard A. Bertsch

Richard A. Bertsch, Director
Technology Center 3700

Attachments: Advisory Action and Notice of Abandonment